

REMARKS

Claims 1, 3 through 9 and 11 are pending in this application. Applicants acknowledge, with appreciation, the Examiner's allowance of claims 1 and 3 through 8. Accordingly, the only remaining issue pivots about the patentability of claims 9 and 11.

Claim 9 has been amended and new claim 11 added. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, Figs. 29 through 38 and the related discussion thereof in the written description of the specification as well as page 18 of the written description, lines 24 through 29. Applicants submit that the present Amendment does not generate any new matter issue.

Claim 9 was rejected under 35 U.S.C. §102 for lack of novelty as evidenced by Kim et al.

In the statement of the rejection, the Examiner referred to Figs. 2A-2I and 3 of Kim et al. asserting the disclosure of a semiconductor device corresponding to that claimed comprising, *inter alia*, a silicon-containing film 102, a silicon film 104 formed thereon, and sidewall insulating films 110 illustrated in Figs. 2D-2D. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. §102 requires identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Products, Inc. v. Total Containment, Inc.*, 258 F.3d 1317, 59 USPQ2d 1489 (F.C. 2001); *Crown Operations International Ltd. V. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). There is a fundamental difference between the claimed semiconductor device and the

device disclosed by Kim et al. that scotches the factual determination that Kim et al. disclose a semiconductor device identically corresponding to that claimed.

Specifically, claim 9 has been clarified by reciting that the sidewall insulating films extend into the substrate to a depth less than that of the first and second trenches. Not so in the device disclosed by Kim et al., wherein the asserted sidewall insulating spacers extend to the bottom of the trenches.

The above argued difference between the claimed semiconductor device and the semiconductor device disclosed by Kim et al. undermines the factual determination that Kim et al. disclose a semiconductor device identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claim 9 under 5 U.S.C. §102 for lack of novelty as evidenced by Kim et al. is not factually viable and, hence, solicit withdrawal thereof.

New Claim 11

New claim 11 is free of the applied prior art by virtue of its dependence upon independence claim 1, noting that independent claim 1 has been allowed.

Based upon the foregoing, it should be apparent that the imposed rejection has been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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